

*Attorney docket GOT 182***REMARKS**

[2] The Examiner's acknowledgment of receipt of priority papers is noted with appreciation. The Applicant requests that the corresponding check boxes on form 326, the first page of the next office action, be checked accordingly.

The drawing was objected to, and corrected drawing sheets were required. The objection and requirement are respectfully traversed. The specification is amended to clarify that Figs. 1 and 3 are partially-schematic views; this is supported in the drawing itself and in the last full paragraph on page 4 and the second full paragraph on page 6.

[3] The Examiner stated that the Applicant should reference copending 10/794,049 on page 1. This requirement is respectfully traversed. The Applicant notes that there is no parent-daughter relationship between these two applications and therefore believes that there is no requirement to refer to the copending application.

[4] The claims were objected to for "displaceable." based on Fig. 1. The objection is respectfully traversed on the grounds that it is Fig. 2, not Fig. 1, which illustrates how the second piston rod 7 is displaceable. Fig. 2 shows, in cross-sectional view, the details of the connection mechanism 80 that allows the displacement. Fig. 1 does not show the mechanism 80 in cross section, so it does not by itself provide the same basis for "displaceable."

The Examiner suggested further explanation, and the specification is amended to provide such further explanation.

[5-6] Claim 1 was rejected over Funkhouser '193 in view of Wilson '609. This rejection is respectfully traversed.

The Examiner's position is understood to be this: the predetermined leakage between the rod 41 and the plug 40 of Funkhouser implies that the inner diameter of the plug 40 is greater than the outer diameter of the rod 41; also, the tubular extension 43 has an inner diameter which is "sufficiently large" to allow some small amount of radial play to the rod 41 within. Thus, there is already some play in the extension 43.

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The Examiner asserts that it would have been obvious to enlarge the inner diameter of the plug 40 to the point where the rod became radially “displaceable” within the scope of claim 1. This assertion is respectfully traversed on the following grounds:

(1) Even if the play between Funkhouser's rod and plug or extension were increased as the Examiner proposes, the subject matter of claim 1 still would not result. Claim 1 reads, *a piston rod connection mechanism that connects at least one of the first piston rod and the second piston rod to the piston such that the one is displaceable in a direction perpendicular to an axis of the piston*

(emphasis added). The recited connection is to the piston, not to the tube.

Funkhouser discloses a perfectly rigid connection among the piston, the upper rod 41, and the lower rod 26—the piston is threaded onto the lower rod 26, and is fitted to the upper rod 41 by a hole “counter-bored” in the piston for that purpose (col. 4, line 15). The drawing shows no clearance between the counter-bored holes and the rod 41, and Funkhouser explicitly states that the whole arrangement is for “securing the rod 41 coaxially to the rod 26” (col. 4, line 14; see also col. 4, line 26). That is, the two rods remain coaxial, which is only possible if each of the two rods 26 and 41 is fastened to the piston without any radial play.

Therefore, Funkhouser would not disclose the feature of claim 1 even if it were modified as the Examiner suggests. New claim 3 recites similar subject matter.

(2) Funkhouser states (col. 4, line 71) that the two separate rods 26 and 41 can be replaced by a one-piece rod. In that case, there would of course be no radial displacement of either one. By teaching the one-piece rod as an acceptable alternative, Funkhouser is seen to teach against radial displacement.

(3) The proposed enlargement of the gap between the rod 41 and the plug 40 is respectfully submitted to be directly contrary to the teaching of Funkhouser, because the reference states that the gap is “predetermined,” that is, it is fixed in size to provide the desired optimized leakage rate. If it were enlarged as the Examiner proposes, then the leakage rate would be greater than Funkhouser intended. Therefore, the person of ordinary skill in the art would not have enlarged it—there is no reason to do so, and there is a clear reason not to do so.

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(4) The Examiner states that it would have been obvious to use the Funkhouser shock absorber as a motorcycle fork like that of Wilson "due to their similar structure." This is respectfully traversed.

First, there is no explanation of what the shared structure is and how this similarity would motivate a person to put the Funkhouser device onto a motorcycle. Neither citation nor reasoned argument is included in support of the statement.

Second, the assertion of similar structure is understood to be an assertion that the Funkhouser shock absorber *could* be used in a motorcycle, that is, an assertion of reasonable expectation of success under MPEP §§ 2143 and 2143.02. The other two required elements of a *prima facie* case for combination, motivation and disclosure of the claim features, are respectfully submitted to be lacking. As is discussed above, claim features are not disclosed by Funkhouser and, furthermore, there is no disclosure of these features in Wilson, either (nor does the rejection assert such disclosure in Wilson). Also as discussed above, Funkhouser does not present any motivation but instead teaches against the Applicant's features.

Funkhouser's shock absorber is intended for use in a vehicle. The reference states (col. 4, lines 45-58) that the tubular extension 43 is "secured to the frame of the vehicle" by the threads 80, using a nut, and the outer end of the rod 26 is "secured to the axle" of the vehicle. Thus, if used on a motorcycle the shock absorber would be bolted onto the steering head.

However, Wilson teaches (col. 1, lines 11-33) that "motorcycle suspensions are of two general types called the conventional type or the inverted type. Conventional type suspensions [have the] primary damping mechanism ... located at the bottom of the suspension Inverted suspensions also consist of a damping mechanism As with the conventional suspensions, the primary damping mechanism is located in the lower cylinder." Thus, according to Wilson, Funkhouser's shock absorber, which would be at the top, does not belong to either of the conventional types suitable for a motorcycle. Wilson's non-conventional inventive strut has shock absorbing structures at both ends, upper and lower (see Fig. 4), so Wilson's invention, just like its prior art, teaches against using Funkhouser in a motorcycle. Funkhouser would result in a shock absorber at *only* the upper end.

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The allowability of claim 2 is noted with appreciation. Claim 2 remains dependent pending the Examiner's consideration of the arguments above for the allowance of claim 1.

Allowance is requested.

Respectfully submitted,

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